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Attorney Docket No. BLD920010034US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re PATENT APPLICATION of:

Carl M. Dennison et al.

Appln. No.: 10/065,527

Filed: October 25, 2002

For: VISUAL JOB TICKETING USING A
DOCUMENT VIEWING APPLICATION

Examiner: Peter K. HUNTSINGER

Art Unit: 2625

APPEAL BRIEF TRANSMITTAL

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Signature



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APPEAL BRIEF UNDER 37 CFR §41.37(a)

Appellants have filed a timely Notice of Appeal from the final Office action, dated February 9, 2006. A single copy of this brief is provided pursuant to 37 C.F.R. §41.37(a). An authorization to charge the appropriate fee is included herewith.

I hereby certify that this Correspondence is being deposited with the United States Postal service with sufficient postage for first class mail in an envelope address to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:
Date of Deposit: July 26, 2006

Typed Name: Charles W. Peterson Jr.

Signature: 

I. Real Party in Interest:

International Business Machines Corporation is the real party in interest in the above referenced patent application.

II. Related Appeals and Interferences:

The appellant is aware of no other appeals or interferences that will directly affect or have a bearing on this appeal.

III. Status of The Claims:

Claims 1 – 20 are currently pending.

Claims 1 – 20 are currently rejected.

Claims 1 – 20 are the subject of this appeal and are appended hereto in the “Claims Appendix” attached hereto.

No claims have been withdrawn, cancelled or allowed.

IV. Status of Amendments:

All prior amendments have been entered.

V. Summary of The Claimed Subject Matter:

Independent Claim 1

The invention, as recited by claim 1, is a method of viewing documents for printing that may use standard document viewing applications that allows job originators

to specify job ticket parameters for an entire document, for individual pages and for groups of pages. *See, e.g.*, paragraphs 0005 and 06 of the application with reference to Figure 3, a copy of which is included as Exhibit A in the Evidence Appendix of this Appeal Brief. The document is changed into an amended document by inserting visual cue objects, for display with displaying the document. Claim 1, lines 2 – 5 and paragraph 0014. The visual cue objects correspond to print job ticketing parameters and corresponding displayed visual cues provide feedback to the job originator about which parameters have been set. Claim 1, line 4 and Paragraph 0006. When specific operations are performed on the amended document, the visual cue objects are removed from the amended document. Claim 1, lines 6 – 8 and Paragraph 0014.

Dependent claim 2 recites that the specific operation may be saving the (amended) document. Paragraph 0014.

Dependent claim 3 recites that the specific operation may be printing the (amended) document. *Id.*

Dependent claim 4 recites that unseen markers are inserted into the document and removed from the amended document before the specific operation. *Id.*

Dependent claim 5 recites a maintaining a list of included visual cues and removing listed visual cues. *Id.*

Dependent claim 17 recites that the visual cue objects are displayed in document thumbnails. Paragraph 0015 and 16.

Dependent claim 6 recites that inserting and removing is done by plug-ins. Paragraphs 0006 and 14.

Dependent claim 7 recites that the plug-ins apply certain print job ticketing parameters to the entire document. Paragraph 0014.

Dependent claim 8 recites that the plug-ins apply certain print job ticketing parameters to the portions of the document. *Id.*

Dependent claim 18 recites that the visual cue objects are displayed in document thumbnails and that the plug-ins monitor the document thumbnails for page selection. Paragraph 0015 and 16.

Independent Claim 9

The invention, as recited by claim 9, is a computer program product for a method of viewing documents for printing that may use standard document viewing applications that allows job originators to specify job ticket parameters for an entire document, for individual pages and for groups of pages. *See, e.g.*, paragraphs 0005 and 06 of the application with reference to Figure 3, and with further reference to Figure 4, a copy of which is included as Exhibit B in the Evidence Appendix of this Appeal Brief. The document is changed into an amended document by inserting visual cue objects, for display with displaying the document. Claim 9, lines 7 – 9 and paragraph 0014. The visual cue objects correspond to print job ticketing parameters and corresponding displayed visual cues provide feedback to the job originator about which parameters have been set. Claim 9, line 9 and Paragraph 0006. When specific operations are performed on the amended document, the visual cue objects are removed from the amended document. Claim 9, lines 10 – 12 and Paragraph 0014.

Dependent claim 10 recites that the specific operation may be saving the (amended) document. Paragraph 0014.

Dependent claim 11 recites that the specific operation may be printing the (amended) document. *Id.*

Dependent claim 12 recites that unseen markers are inserted into the document and removed from the amended document before the specific operation. *Id.*

Dependent claim 13 recites a maintaining a list of included visual cues and removing listed visual cues. *Id.*

Dependent claim 19 recites that the visual cue objects are displayed in document thumbnails. Paragraph 0015 and 16.

Dependent claim 14 recites that inserting and removing is done by plug-ins. Paragraphs 0006 and 14

Dependent claim 15 recites that the plug-ins apply certain print job ticketing parameters to the entire document. Paragraph 0014.

Dependent claim 16 recites that the plug-ins apply certain print job ticketing parameters to the portions of the document. *Id.*

Dependent claim 20 recites that the visual cue objects are displayed in document thumbnails and that the plug-ins monitor the document thumbnails for page selection. Paragraph 0015 and 16.

VI. Grounds of Rejection to Be Reviewed on Appeal:

1. Claims 1, 3 – 5, 9 and 11 – 13 are finally rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,614,454 to Livingston.

2. Claims 2 and 10 are finally rejected under 35 U.S.C. §103(a) over Livingston in combination with U.S. Patent No. 6,880,124 to Moore.

3. Claims 6 – 8 and 14 – 16 are finally rejected under 35 U.S.C. §103(a) over Livingston in combination with published U.S. Patent Application No. 2202/0184305 to Simpson et al.

4. Claims 17 and 19 are finally rejected under 35 U.S.C. §103(a) over Livingston in combination with U.S. Patent No. 6,268,924 to Koppolu et al.

5. Claims 18 and 20 are finally rejected under 35 U.S.C. §103(a) over Livingston and Simpson et al. in further combination with Koppolu et al.

VII. Argument:

REJECTION UNDER 35 U.S.C. §102(e)

CLAIMS 1, 3 – 5, 9 and 11 – 13 over U.S. Patent No. 6,614,454 to Livingston

Livingston fails, both literally and inherently, to disclose specifically recited features of claims 1, 3 – 5, 9 and 11 – 13. Both of Livingston and the present application are clearly different by the representation in the Figures of each and by the plain language of each. Therefore, *prima facie* anticipation under 35 U.S.C. §102(e) has not been shown for any of finally rejected claims 1, 3 – 5, 9 and 11 – 13.

“A claim is anticipated only if each and every element **as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference.”¹ “The identical invention must be shown in as complete detail as is contained in the ... claim.”² Furthermore, “[d]uring patent examination, the pending claims must be ‘given *>their< broadest **reasonable** interpretation consistent with the specification.’ >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)”³ Moreover, that “broadest reasonable interpretation of the claims **must also be consistent** with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).”⁴

Livingston teaches a “graphical user interface [GUI that] is configured to allow user selection and modification of print engine options for printing the document.”⁵ See, e.g., Livingston Figure 3A, a copy of which is included as Exhibit C in the Evidence Appendix of this Appeal Brief. More specifically, one can use the Livingston GUI to

1 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

2 *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

3 MPEP, §2111 (emphasis added).

4 *Id.* (emphasis added).

5 col. 2, lines 19 – 2.

configure the printer, selecting print engine options to configure/control the printer, which operates on the printer not the document being printed. Moreover, while the claims clearly recite “creating an amended document,”⁶ not an amended GUI image and, thereafter, operating on the amended document; Livingston fails to teach anything that could be considered “an amended document” (as recited by claims 1 and 9) that is “consistent with the specification.”⁷

However, it is asserted in the Final Office action (Final) that, “[a]ccording to the **definition within the art**, a document is a writing that contains information. The **print preview image is therefore a document**. When the print preview image is changed by placing visual cues in the document, an amended document is created.” (emphasis added). In response to the appellants challenge of this assertion, the Advisory action asserted that, “[t]he definition within the art of document [sic] is a writing that contains information. Support of this definition is found from www.dictionary.com.” Regardless, however, this www.dictionary.com definition (Definition) the does not state that a “print preview image is therefore a document” and certainly does not support “consistent with the specification,”⁸ finding that the “print preview image is therefore a document.”

Finally rejected claim 4 (and claim 12) recites, for example, “wherein said step of inserting further includes **inserting an unseen marker** with each of the plurality of visual cue objects and wherein said step of removing the at least one of the plurality of visual cue objects further includes **locating the unseen marker**.”⁹ As described in the application, “the plug-ins add a hidden or unseen marker to the visual cue objects, ..., the plug-ins search each page for visual cue objects and remove them, so that the saved or printed document does not include the cues. ... The job ticket parameters represented by

⁶ e.g., claim 1 at line 4.

⁷ *Supra*.

⁸ *Id.*

⁹ Lines 1 – 4 (emphasis added).

the visual cues are stored or printed via the job ticket instead.”¹⁰ This is clearly inconsistent with asserting that a “print preview image is therefore a document” to render claims 4 and 12 nonsensical and is, therefore, neither “consistent with the specification”¹¹ nor with the claims.

Neither is finding that a “print preview image is therefore a document” consistent with the teaching of Livingston. “In the example of FIG. 3A, the second visually distinctive fashion displays the feature in bold text to indicate that the ‘Watermark’ feature has been modified from the default value for at least one page of the **document** that is being previewed in the **print preview image 68**.”¹² Nor is such a finding supported by the Definition, which specifically recites “d. Computer Science. A piece of work created with an application, as by a word processor. e. Computer Science. A computer file that is not an executable file and contains data for use by applications.” So, from the broad range of arts encompassed by computer science, a document is a file such as a word processor file. Thus at least in part, the basis for finally rejecting claims 1, 3 – 5, 9 and 11 – 13 over Livingston is supported neither by Livingston, nor by the broader “definition within the art” from the Definition, nor from “broadest reasonable interpretation consistent with the specification.”¹³ Accordingly, *prima facie* anticipation has not been established under 35 U.S.C. §102(e) for any of finally rejected claims 1, 3, 5, 9, 11 and 13 and especially for claims 4 and 12.

Furthermore, because Livingston does not teach inserting visual cues into an original document to create an amended document “consistent with the specification,”¹⁴ and does not teach removing the visual cues from the amended document as claims 1 and 9 recite; Livingston fails to perform “**the identical function** specified in the claim [1 or

¹⁰ Paragraph 0014.

¹¹ *Id.*

¹² Livingston, col. 5, lines 45 – 50 (emphasis added).

¹³ *Supra.*

¹⁴ *Supra.*

9] in **substantially the same way**, and [fails to produce] **substantially the same results.**”¹⁵ Thus, the appellants have shown that reading the finally rejected claims onto Livingston is inconsistent with both the Livingston specification and the present application. Therefore, the appellants have met their burden in overcoming any allegation equivalency, i.e., that indeed, the print preview image is not a document.

Therefore, since the present invention, as recited in claims 1, 3 – 5, 9 and 11 – 13, is quite different and operates quite differently than the Livingston GUI; Livingston does not teach the present invention or an equivalent thereof, and so, does not anticipate the present invention as recited in any of claims 1, 3 – 5, 9 and 11 – 13. Since Livingston does not anticipate the present invention, under 35 U.S.C. §102(e) and the final rejection of claims 1, 3 – 5, 9 and 11 – 13 must be reversed.

REJECTION UNDER 35 U.S.C. §103(a)

Neither does Livingston or any reference of record suggest the above elements of claims 1 or 9, that the appellants have noted are missing from Livingston, to result in the present invention as recited by claims 2, 6 – 8, 10 or 14 – 20, which depend from claims 1 and 9, respectively. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the **references.**”¹⁶

¹⁵ MPEP§2184 entitled, “Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a *Prima Facie* Case Is Made”

¹⁶ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added).

CLAIMS 2 and 10 over Livingston in combination with U.S. Patent No. 6,880,124 to Moore

Neither does Moore suggest the above noted missing elements to result in the present invention in combination with Livingston. Moore is cited because “Moore discloses automatically saving a document when printing (col. 7, lines 12-18).” This is clearly inconsistent with the allegation that “print preview image is ... a document.” How and why would one save a print preview image? Clearly, the print preview image is just a representation of what may be only a small part of the document being saved/printed. Neither is “automatically saving a document when printing” what either claim 2 or 10 recites, i.e., “removing from the amended document, for [printing] to be performed on the amended document, at least one of the plurality of visual cue objects and”¹⁷ printing. Therefore, the combination of Livingston and Moore does not result in the present invention and *prima facie* obviousness under 35 U.S.C. §103(a) has not been shown for finally rejected claims 2 or 10.

CLAIMS 6 – 8 and 14 – 16 over Livingston in combination with published U.S. Patent Application No. 2002/0184305 to Simpson et al.

Neither does Simpson et al. suggest the above noted missing elements to result in the present invention in combination with Livingston. Simpson et al. is cited to “disclose plug-in [sic] to a document editor providing a plug-in interface (page 1, paragraph 3).” However, because Simpson et al. fails to teach the above identified elements missing from Livingston, using plug-ins to perform Livingston fails to result in the present invention. Therefore, the combination of Livingston and Simpson et al. does not result in the present invention and *prima facie* obviousness under 35 U.S.C. §103(a) has not been shown for any of finally rejected claims 6 – 8 and 14 – 16.

¹⁷ Claims 1 and 2.

CLAIMS 17 – 20 over Livingston in combination with U.S. Patent No. 6,268,924 to Koppolu et al. alone or further in combination with Simpson et al.

Neither does Koppolu et al. alone, or further in combination with Simpson et al. suggest the above noted missing elements to result in the present invention in combination with Livingston. Koppolu et al. is cited to teach “a print preview being a thumbnail.” However, asserting that the Livingston image 68 is a thumbnail fails to result in the present invention as recited in claims 1 and 9, much less claims 17 and 19, which depend therefrom. Similarly, asserting that operating the Livingston GUI as a plug-in (as recited in Simpson et al.) with the Livingston image 68 being a thumbnail, also fails to result in the present invention as recited in claims 1 and 9, much less claims 18 and 20, which depend therefrom. Therefore, the combination of Livingston Koppolu et al. alone, or further in combination with Simpson et al., does not result in the present invention and *prima facie* obviousness under 35 U.S.C. §103(a) has not been shown for any of finally rejected claims 17 – 20.

Accordingly, since Livingston in combination with Moore, Simpson et al., Koppolu et al., alone or in further combination with each other, does not result in the present invention as recited in claims 2, 6 – 8, 10 and 14 – 20; *prima facie* obviousness under 35 U.S.C. §103(a) has not been shown for any of finally rejected claims 2, 6 – 8, 10 and 14 – 20 and the final rejection must be reversed.

CONCLUSION


Livingston does not literally anticipate the present invention because the claims clearly recite “creating an amended document,” not an amended GUI image and, thereafter, operating on the amended document; and because Livingston fails to teach anything that could be considered “an amended document” (as recited by claims 1 and 9)

that is "consistent with the specification."¹⁸ Livingston does not teach equivalent structure or steps to anticipate the present invention because Livingston teaches "at least one page of the document ... is being previewed in the print preview image 68;"¹⁹ and because asserting that the document is the GUI image is not supported by the Definition; nor is it supported given "broadest reasonable interpretation consistent with the specification."²⁰ Neither does any of the cited references suggest or provide anything to cure these shortcomings to result in claims 1 and 9, much less claims depending therefrom. Therefore, anticipation under 35 U.S.C. §102(e) has not been shown for any of finally rejected claims 1, 3 – 5, 9 and 11 – 13; and, obviousness under 35 U.S.C. §103(a) has not been shown for any of finally rejected claims 2, 6 – 8, 10 or 14 – 20. The Appellants respectfully request that the board reverse the rejection of claims 1, 3 – 5, 9 and 11 – 13 under 35 U.S.C. §102(e) and claims 2, 6 – 8, 10 or 14 – 20 under 35 U.S.C. §103(a).

Respectfully submitted,

July 26, 2006
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¹⁸ *Supra.*

¹⁹ *Supra.*

²⁰ *Supra.*

CLAIMS APPENDIX

A copy of the claims involved in the appeal is provided below.

1. A method comprising:
displaying a plurality of original document visual objects of an original document;
inserting into the original document a plurality of visual cue objects
corresponding to print job ticketing parameters, thereby creating an amended document,
and displaying the plurality of visual cue objects; and
removing from the amended document, for specific operations to be performed on
the amended document, at least one of the plurality of visual cue objects and performing
the specific operations.
2. The method of claim 1 wherein the specific operation is a save operation.
3. The method of claim 1 wherein the specific operation is a print operation.
4. The method of claim 1 wherein said step of inserting further includes inserting an
unseen marker with each of the plurality of visual cue objects and wherein said step of
removing the at least one of the plurality of visual cue objects further includes locating
the unseen marker.
5. The method of claim 1 wherein said step of inserting further includes maintaining
a list of each of the plurality of visual cue objects inserted and wherein said step of
removing the at least one of the plurality of visual cue objects further includes
referencing the list and identifying the at least one of the plurality of visual cue objects to
be removed.
6. The method of claim 1 wherein said steps of inserting and removing are
performed by a plug-in to a document editor providing a plug-in interface.

7. The method of claim 6 wherein the plug-in is further effective in performing the step of:
applying certain of the print job ticketing parameters to all pages of the document.
8. The method of claim 6 wherein the plug-in is further effective in performing the step of:
applying certain of the print job ticketing parameters to selected pages of the document.
9. A program product comprising:
a computer readable medium; and
program instructions on said medium which, when executing on a processor, are effective to:
display a plurality of original document visual objects of an original document;
insert into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document, and display the plurality of visual cue objects; and
remove from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects and performing the specific operations.
10. The product of claim 9 wherein the specific operation is a save operation.
11. The product of claim 9 wherein the specific operation is a print operation.
12. The product of claim 9 wherein said insertion further includes inserting an unseen marker with each of the plurality of visual cue objects and wherein said removal of the at least one of the plurality of visual cue objects further includes locating the unseen marker.

13. The product of claim 9 wherein said insertion further includes maintaining a list of each of the plurality of visual cue objects inserted and wherein said removal of the at least one of the plurality of visual cue objects further includes referencing the list and identifying the at least one of the plurality of visual cue objects to be removed.
14. The product of claim 9 wherein said insertion and removal are performed by a plug-in to a document editor providing a plug-in interface.
15. The product of claim 14 wherein the plug-in is further effective to apply certain of the print job ticketing parameters to all pages of the document.
16. The product of claim 14 wherein the plug-in is further effective to apply certain of the print job ticketing parameters to selected pages of the document.
17. A method as in claim 1, wherein said step of inserting further includes displaying the plurality of visual cue objects in thumbnails.
18. A method as in claim 6, wherein said step of inserting further includes displaying the plurality of visual cue objects in thumbnails, said plug-in further monitoring said thumbnails for current page selection.
19. A program product as in claim 9, further comprising program instructions that cause the processor to display the plurality of visual cue objects in thumbnails.
20. A program product as in claim 19 further comprising program instructions that cause the processor to display the plurality of visual cue objects in thumbnails, said plug-in further monitoring said thumbnails for current page selection.

EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 35 U.S.C. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 35 U.S.C. §41.37(c)(ix).

Exhibit	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
A	Application Figure 3	Originally filed application and with the application filed October 25, 2002
B	Application Figure 4	Originally filed application and with the application filed October 25, 2002
C	Livingston Figure 3A	Cited in the first Office action mailed August 26, 2005
D		
E		
F		
G		
H		
I		
J		
K		

EXHIBIT A

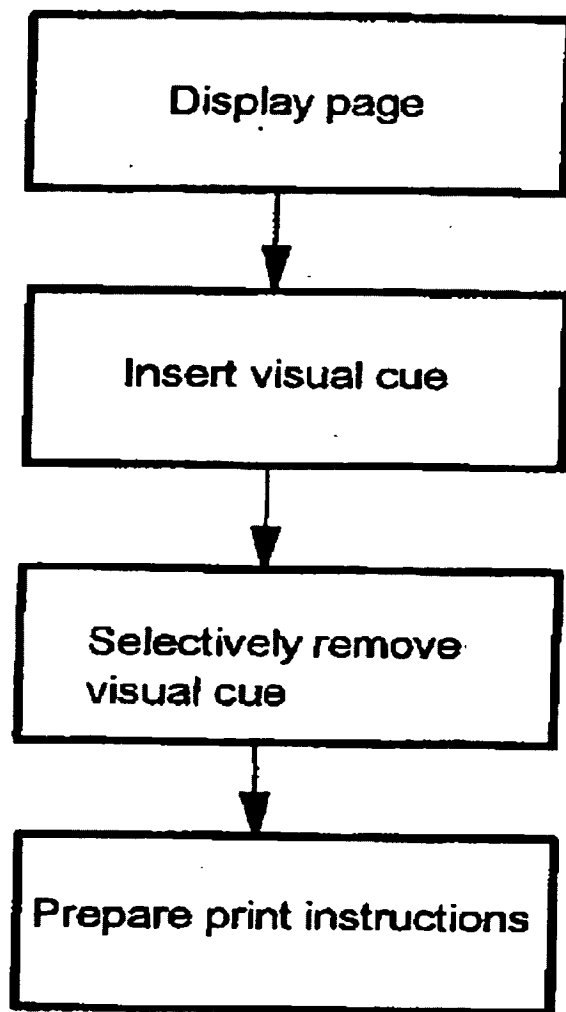


Fig. 3

EXHIBIT B

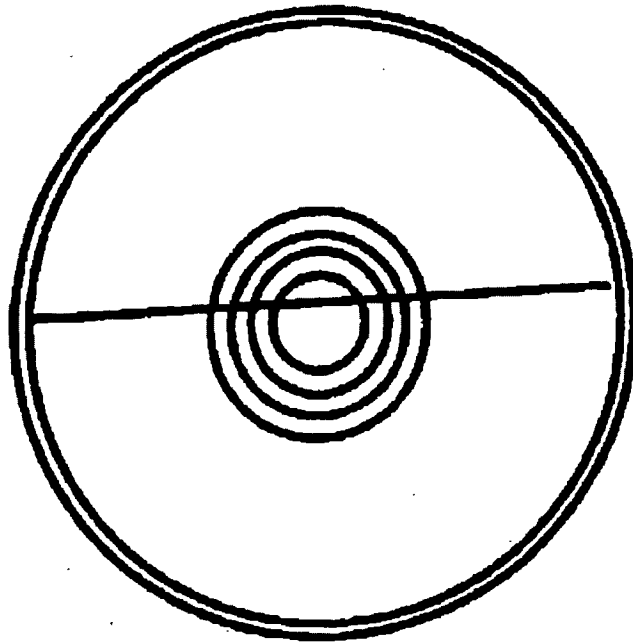
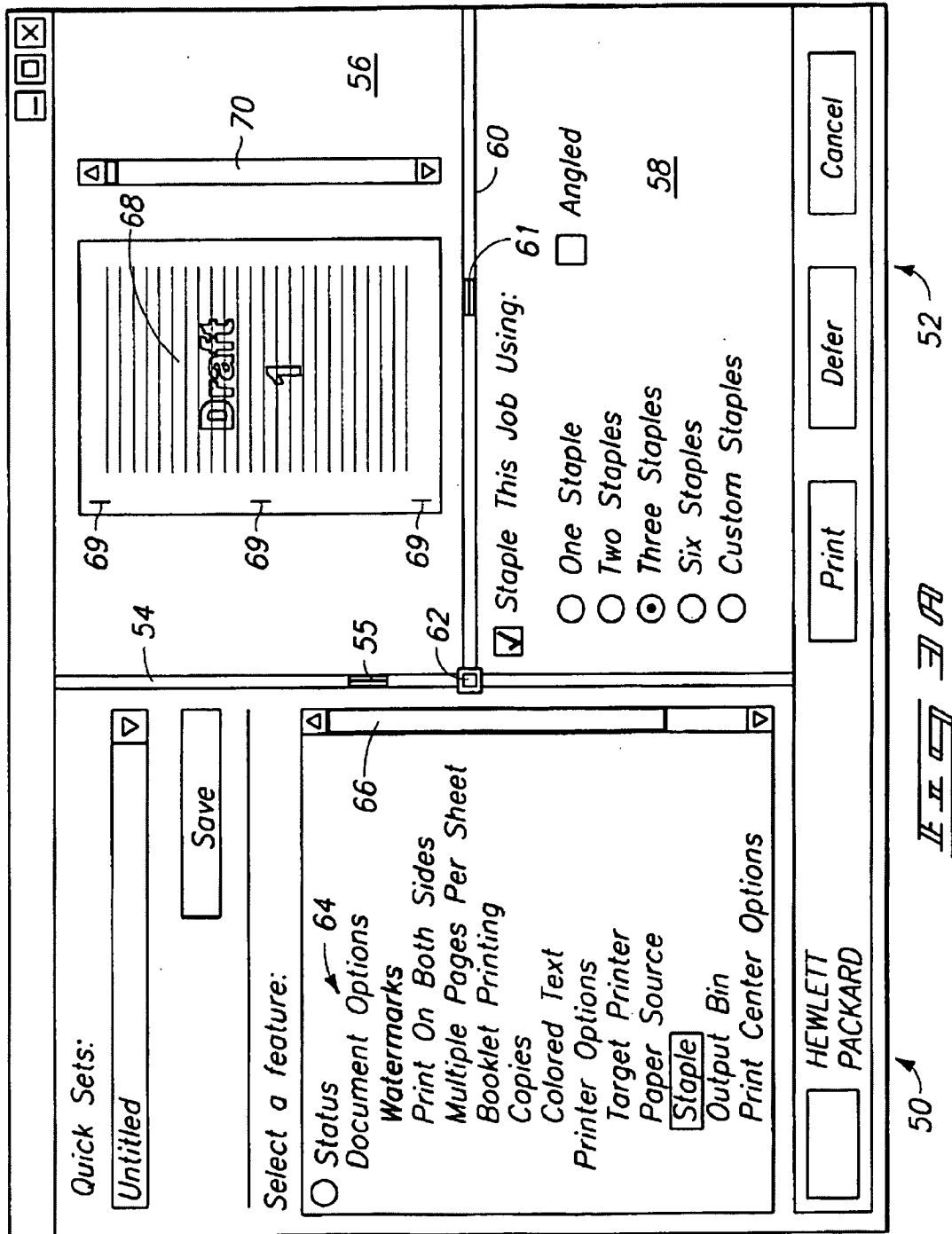


Fig. 4

EXHIBIT C



RELATED PROCEEDINGS APPENDIX

Pursuant to 35 U.S.C. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 35 U.S.C. §41.37(c)(1)(ii) are enclosed herewith. As appellants are aware no decisions or proceedings having a bearing on the present appeal, nothing is included in the Appendix.